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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/632,132  
Filing Date: July 30, 2003  
Appellant(s): CARROLL, JEREMY JOHN

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Dan C. Hu  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 06/22/2009 appealing from the Office action mailed 01/21/2009.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

Claim 14 is rejected under 35 U.S.C. 112, ¶1, as failing to comply with the written description requirement.

Claim 14 is rejection under 35 U.S.C. 101 because the claim is directed to "non-functional descriptive material".

Claims 1-2, 5-14 and 18-23 are rejection under 35 U.S.C. 103(a)

as unpatentable over Owa (US Patent Number 6,348,971) in view of Van Oijen (US Patent Number 5,918,988).

Claims 3 and 4 are rejection under 35 U.S.C. 103(a) as unpatentable over Owa (US Patent Number 6,348,971) in view of Ueda (US Patent Number 5,918,988).

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

6,348,971	Owa et al.	02-2002
5,918,988	Van Oijen	07-1999
7,046,383	Ueda et al.	05-2006

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claim 14 is rejected under 35 U.S.C. 112, ¶1, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 14 claims "**a computer readable media**", however, there is no support in the specification for having a computer readable media storing thereon a computer program to perform the desired claimed invention.

Claim 14 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 14 is drawn to non-functional descriptive material.

MPEP 2106.01.V (Nonstatutory Subject Matter) states:

"When nonfunctional descriptive material is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement".

Claim 14 currently recites "**a computer readable media having stored thereon a computer program**". The 101 rejection made in the 6/6/07 OA was for the reason of "non-functional descriptive material". "When nonfunctional descriptive material i.e. "data carrier" is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement", see MPEP 2106.01. Thus, treating claim 14 as a whole, it is non statutory.

Claims 1-2,5-14 and 18-23 rejected under 35 U.S.C. 103(a) as being unpatentable over Owa et al. (US Patent Number 6,348,971 B2) in view of Van Oijen (US Patent Number 5,918,988).

Regarding claim 1: As shown in figure 1, Owa et al. disclose a method of printing at least one print job in a computer-based printer system (**1, 5 figure 1, column 3, lines 16-22**), the system comprising at least one printer and at least one computer connected to said at least one printer (**column 3, lines 16-22; note that a host computer 1 and one or more of printers 5, 2a-2d are connected**), wherein the at least one printer has

a plurality of different printing configurations (**column 3, lines 51-65; note that the printers have different configurations i.e. model names, performance, additional functions**) at least one of which is manually configurable (**column 3, line 66-column 4, line 5; note that user can also manually set up the desired configuration**) and the at least one computer is capable of generating said at least one print job (**11, figure 2, column 4, lines 44-52; note that the data transfer section 17 passes the print data generated by the print data generation section 18 to the operating system of the host computer<sup>1</sup>, for transferring the print data to the printer selected by the output destination printer selection section 11**), said at least one print job having corresponding printing requirements (**column 5, lines 1-8; note that such requirement is considered as a color/monochrome, paper size, resolution, double-side printing etc.**), each printing configuration being capable of satisfying one or more printing requirements (**column 5, lines 16-20; note that for text printing the desired print quality and size gets satisfied by the selected printer**), the method comprising the steps of using the printing system to:

- i) create one or more print jobs (**column 4, lines 44-48; print data gets generated**);
- ii) determine whether or not the print job or each print job can be printed using said at least one printer by comparing the printing requirements of the print job or each print job and the current printing configurations of the at least one printer (**column 5, lines 30-44; note that the printer selection condition section compares the set up print conditions with the basic information of the printer**);

iii) when one of more of the print jobs cannot be printed using said at least one printer on the basis of said plurality of different printing configurations (**column 5, lines 45-57; note that the printer which does not satisfy the printing requirement does not get selected so the print job does not get processed to be printed**).

Owa et al. disclose all of the subject matter as described as above except for specifically teaching to automatically determining at least one reconfiguration of the printer configuration(s) that would be capable of satisfying the printing requirement(s) of said one or more print job(s) and performing such a reconfiguration of the printer configuration automatically or providing information to enable such a reconfiguration to be carried out manually.

However, as shown in figures 1-2, Van Oijen teaches a printing system which receives print jobs then make manual and automatic configuration. Van Oijen also discloses automatically determining at least one reconfiguration of the printer configuration(s) that would be capable of satisfying the printing requirement(s) of said one or more print job(s) (**column 5, lines 1-12; note that the printer are configured based on the different requirements to selectively prints print jobs in dependence on the job specifications of the other jobs**) and performing such a reconfiguration of the printer configuration automatically or providing information to enable such a reconfiguration to be carried out manually (**column 5, lines 12-20; note that it is checked whether manual or automatic setting is set before manually setting the printer based on the print conditions. Then manual print mode gets selected for the print job to be carried out**).

Owa et al. and Van Oijen are combinable because they are from the same field of endeavor i.e. processing data for printer. At the time of the invention, it would have been obvious to a person of ordinary skilled in the art to automatically determining at least one reconfiguration of the printer configuration(s) that would be capable of satisfying the printing requirement(s) of said one or more print job(s) and performing such a reconfiguration of the printer configuration automatically or providing information to enable such a reconfiguration to be carried out manually. The suggestion/motivation for doing so would have been to provide a printing system which can operate in different modes thus improving the possible uses and versatility of a printing system (column 1, lines 49-58). Therefore, it would have been obvious to combine Owa et al. with Van Oijen to obtain the invention as specified in claim 1.

Regarding claim 2: Owa et al. disclose all of the subject matter as described as above except for specifically teaching to determine when said reconfiguration would require manual reconfiguration of said one or more printer(s) by a user of the printing system, and if so using the printing system to generate and present to said user instruction for manually reconfiguring said one or more printer(s) prior to printing of the print one or more job(s) by the printing system.

However, Van Oijen discloses to determine when said reconfiguration would require manual reconfiguration of said one or more printer(s) by a user of the printing system (**column 5, lines 12-15; note that it is checked whether manual or automatic setting is set before manually setting the printer based on the print**



**conditions. Then manual print mode gets selected for the print job to be carried out ) and if so using the printing system to generate and present to said user instruction for manually reconfiguring said one or more printer(s) prior to printing of the print one or more job(s) by the printing system (column 5, lines 15-20; note that user can manually select conditions in order to process the print jobs. Also, the instruction is displaying in the screen).**

Owa et al. and Van Oijen are combinable because they are from the same field of endeavor i.e. processing data for printer. At the time of the invention, it would have been obvious to a person of ordinary skilled in the art to determine when said reconfiguration would require manual reconfiguration of said one or more printer(s) by a user of the printing system, and if so using the printing system to generate and present to said user instruction for manually reconfiguring said one or more printer(s) prior to printing of the print one or more job(s) by the printing system. The suggestion/motivation for doing so would have been to provide a printing system which can operate in different modes thus improving the possible uses and versatility of a printing system (column 1, lines 49-58). Therefore, it would have been obvious to combine Owa et al. with Van Oijen to obtain the invention as specified in claim 2.

Regarding claim 5: Owa et al. further disclose a method as claimed in claim 1, in which there are a plurality of different preferred reconfigurations which would involve both manual configuration by the user (column 5, line 64-column 6, line 5; note that if there is no printers to be selected based on the print requirements, a message

**gets displayed for the user to manually enter print conditions)** and automatic configuration by the printing system (**column 6, lines 6-26; note that if there is no printer satisfying the printing requirements, an alternative condition gets checked and an alternative printer gets selected to process the print job this configuration gets established without user's manual setting i.e. automatically).**

Regarding claim 6: Owa et al. further disclose a method as claimed in claim 1, in which there are a plurality of different preferred reconfigurations, and prior to step iv) these preferred configurations are presented to user of the printing system so that the user can select a particular reconfiguration, for which reconfiguration instructions are then presented in step iv) (**column 5, line 64-column 6, line 5; note that if there is no printers to be selected based on the print requirements, a message gets displayed for the user to manually enter print conditions).**

Regarding claim 7: Owa et al. further disclose a method as claimed in claim 2, in which a computer includes a user display, and said presentation of instructions includes the display of reconfiguration instructions on the user display (**column 5, line 64-column 6, line 5; note that if there is no printers to be selected based on the print requirements, a message gets displayed for the user to manually enter print conditions).**

Regarding claim 8: Owa et al. further disclose a method as claimed in claim 2, in which said presentation of instructions includes the printing of reconfiguration instructions on a printer (**column 7, lines 12-22**).

Regarding claim 9: Owa et al. further disclose a method as claimed in claim 8, in which a computer includes a user display, in which said presentation of instructions includes a message displayed on the user display informing the user that reconfiguration instructions are to be printed on said printer (**column 7, lines 12-22; column 10, lines 35-43**).

Regarding claim 10: Owa et al. further disclose a method as claimed claim 1, in which after reconfiguration of the printer(s) (**column 6, lines 6-12; note that the printers are selected based on the condition items assigned**), the print job is assigned to more than one printer (**column 6, lines 12-17; note that more than one printers are to be selected based on the information on each printer**), and the printing system presents to a user of the printing system instructions for any or all of locating, assembling, collating, binding, or otherwise combining material printed from the printers (**column 4, line 66-column 5, lines 5; note that print location is gets specified to user**).

Regarding claim 11: Owa et al. further disclose a method as claimed in claim 10, in which the print job has a plurality of different parts (**column 8, lines 7-10**), each part

having different printing requirements (**column 8, lines 14-24**), and the print job is split according to those different requirements (**column 8, lines 24-31**).

Regarding claim 12: As shown in figure 1, Owa et al. disclose a computer-based printing system, the printing system comprising at least one printer and at least one computer connected to said printer(s) (**column 3, lines 16-22; note that a host computer 1 and one or more of printers 5, 2a-2d are connected**), the or each printer having a plurality of different printing configurations (**column 3, lines 51-65; note that the printers have different configurations i.e. model names, performance, additional functions**) at least one of which is manually configurable (**column 3, line 66-column 4, line 5; note that user can also manually set up the desired configuration**) and the or each computer being capable of generating at least one print job (**11, figure 2, column 4, lines 44-52; note that the data transfer section 17 passes the print data generated by the print data generation section 18 to the operating system of the host computer1, for transferring the print data to the printer selected by the output destination printer selection section 11**), said print job(s) having corresponding printing requirements (**column 5, lines 1-8; note that such requirement is considered as a color/monochrome, paper size, resolution, double-side printing etc.**), each printing configuration being capable of satisfying one or more printing requirements (**column 5, lines 16-20; note that for text printing the desired print quality and size gets satisfied by the selected printer**), wherein the printing system is arranged to:

determine whether or not each print job can be printed using said printer(s) by comparing the printing requirements of the or each print job and the current printing configurations of the printer(s) (**column 5, lines 30-44; note that the printer selection condition section compares the set up print conditions with the basic information of the printer**); and

when one or more of the print jobs cannot be printed using said printer(s) on the basis of said current printing configuration (**column 5, lines 45-57; note that the printer which does not satisfy the printing requirement does not get selected so the print job does not get processed to be printed**), to determine automatically at least one reconfiguration of the printer configuration(s) that would be capable of satisfying the printing requirement(s) of said print job(s) (**column 6, lines 6-26; note that if there is no printer satisfying the printing requirements, an alternative condition gets checked and an alternative printer gets selected to process the print job**).

Owa et al. disclose all of the subject matter as described as above except for specifically teaching when said reconfiguration would require manual reconfiguration of said printer(s) by a user of the printing system, then use the printing system to generate and present to said user instructions for manually reconfiguring said printer(s) prior to printing of the print job(s) by the printing system.

However, Van Oijen discloses when said reconfiguration would require manual reconfiguration of said one or more printer(s) by a user of the printing system (**column 5, lines 12-15; note that it is checked whether manual or automatic setting is set**

**before manually setting the printer based on the print conditions. Then manual print mode gets selected for the print job to be carried out)** then use the printing system to generate and present to said user instruction for manually reconfiguring said one or more printer(s) prior to printing of the print one or more job(s) by the printing system **(column 5, lines 15-20; note that user can manually select conditions in order to process the print jobs. Also, the instruction is displaying in the screen).**

Owa et al. and Van Oijen are combinable because they are from the same field of endeavor i.e. processing data for printer. At the time of the invention, it would have been obvious to a person of ordinary skilled in the art when said reconfiguration would require manual reconfiguration of said one or more printer(s) by a user of the printing system, then use the printing system to generate and present to said user instruction for manually reconfiguring said one or more printer(s) prior to printing of the print one or more job(s) by the printing system. The suggestion/motivation for doing so would have been to provide a printing system which can operate in different modes thus improving the possible uses and versatility of a printing system (column 1, lines 49-58). Therefore, it would have been obvious to combine Owa et al. with Van Oijen to obtain the invention as specified in claim 12.

Regarding claim 13: Owa et al. further disclose a computer system programmed for providing print job information to printers connected to the computer system by a computer network **(column 3, lines 16-22; note that a host computer 1 and one or**

**more of printers 5, 2a-2d are connected**), wherein one or more processors of the computer system are programmed to:

create a print job (**column 4, lines 44-48; print data gets generated**);

determine whether or not the print job can be printed using one or more printers in communication with the computer system by comparing the printing requirements of the print job and the current printing configurations of the one or more printers (**column 5, lines 30-44; note that the printer selection condition section compares the set up print conditions with the basic information of the printer**);

when the print job cannot be printed using the one or more printers in their current printing configuration (**column 5, lines 45-57; note that the printer which does not satisfy the printing requirement does not get selected so the print job does not get processed to be printed**), automatically determine at least one reconfiguration of the one or more printers that would be capable of satisfying the printing requirements of said print job (**column 6, lines 6-26; note that if there is no printer satisfying the printing requirements, an alternative condition gets checked and an alternative printer gets selected to process the print job**); and

Owa et al. disclose all of the subject matter as described as above except for specifically teaching to provide information to enable such a reconfiguration to be carried out by another.

However, Van Oijen discloses to provide information to enable such a reconfiguration to be carried out by another (**column 5, lines 15-20; note that user**

**can manually select conditions in order to process the print jobs. Also, the instruction is displaying in the screen).**

Owa et al. and Van Oijen are combinable because they are from the same field of endeavor i.e. processing data for printer. At the time of the invention, it would have been obvious to a person of ordinary skilled in the art to provide information to enable such a reconfiguration to be carried out by another. The suggestion/motivation for doing so would have been to provide a printing system which can operate in different modes thus improving the possible uses and versatility of a printing system (column 1, lines 49-58). Therefore, it would have been obvious to combine Owa et al. with Van Oijen to obtain the invention as specified in claim 13.

Regarding claim 14: As shown in figure 8, Owa et al. further disclose computer readable media having stored thereon a computer program containing code adapted to program one or more processors of a computer system to **(45, 41, 61 figure 8; column 9, lines 31-44; note that the print data generating system communicates with the printer)**:

obtain current printing configurations of one or more printers in communication with the computer system **(column 9, lines 45-56; note that the printer driver generates print data to be output to the printer)**;

determine whether or not a print job can be printed using such one or more printers by comparing the printing requirements of the print job and the current printing configuration of the one or more printers **(column 5, lines 30-44; note that the printer**



**selection condition section compares the set up print conditions with the basic information of the printer);**

when the print job cannot be printed using the one or more printers in their current printing configuration (**column 5, lines 45-57; note that the printer which does not satisfy the printing requirement does not get selected so the print job does not get processed to be printed**), automatically determine at least one reconfiguration of the one or more printers that would be capable of satisfying the printing requirements of the print job (**column 6, lines 6-26; note that if there is no printer satisfying the printing requirements, an alternative condition gets checked and an alternative printer gets selected to process the print job**).

Owa et al. disclose all of the subject matter as described as above except for specifically teaching to perform such a reconfiguration of the one or more printers when such reconfiguration can be done automatically and providing information to enable such a reconfiguration to be carried out by another when such reconfiguration cannot be done automatically.

However, Van Oijen discloses to perform such a reconfiguration of the one or more printers when such reconfiguration can be done automatically and providing information to enable such a reconfiguration to be carried out by another when such reconfiguration cannot be done automatically (**column 5, lines 15-20; note that user can manually select conditions in order to process the print jobs. Also, the instruction is displaying in the screen**).

Owa et al. and Van Oijen are combinable because they are from the same field of endeavor i.e. processing data for printer. At the time of the invention, it would have been obvious to a person of ordinary skilled in the art to perform such a reconfiguration of the one or more printers when such reconfiguration can be done automatically and providing information to enable such a reconfiguration to be carried out by another when such reconfiguration cannot be done automatically. The suggestion/motivation for doing so would have been to provide a printing system which can operate in different modes thus improving the possible uses and versatility of a printing system (column 1, lines 49-58). Therefore, it would have been obvious to combine Owa et al. with Van Oijen to obtain the invention as specified in claim 14.

Regarding claim 18: Owa et al. further disclose a method as claimed in claim 1 wherein the at least one reconfiguration of the printer configuration(s) capable of satisfying the printing requirement(s) of said print job(s) is determined by automatically analyzing a set of plausible reconfigurations (**column 7, line 67-column 8, line 4; note that satisfying the conditions desired by the user i.e. a print installed at a close location and operating at high speed is considered as a plausible configuration**).

Regarding claim 19: Owa et al. further disclose a method as claimed in claim 18 wherein the set of plausible reconfigurations is determined by iterating through features associated with said one or more printers (**column 7, lines 48-67; note that the**

**scores associated with printers PRN1-PRN3 is described. Also, the scores are given according to the speed configuration of the printers which is considered as the iterating feature of printers based on their speed capacity).**

Regarding claim 20: Owa et al. further disclose a computer-based printing system as claimed in claim 12 wherein the at least one reconfiguration of the printer configuration(s) capable of satisfying the printing requirement(s) of said print job(s) is determined by automatically analyzing a set of plausible reconfigurations (**column 7, line 67-column 8, line 4; note that satisfying the conditions desired by the user i.e. a print installed at a close location and operating at high speed is considered as a plausible configuration).**

Regarding claim 21: Owa et al. further disclose a computer-based printing system 20 wherein the set of plausible reconfigurations is determined by iterating through features associated with said one of more printers (**column 7, lines 48-67; note that the scores associated with printers PRN1-PRN3 is described. Also, the scores are given according to the speed configuration of the printers which is considered as the iterating feature of printers based on their speed capacity).**

Regarding claim 22: Owa et al. further disclose a computer system as claimed in claim 13 wherein the at least one reconfiguration of the printer configuration of the

printer configuration(s) capable of satisfying the printing requirements(s) of said print job(s) is determined by automatically analyzing a set of plausible reconfigurations **(column 7, line 67-column 8, line 4; note that satisfying the conditions desired by the user i.e. a print installed at a close location and operating at high speed is considered as a plausible configuration).**

Regarding claim 23: Owa et al. further disclose a computer system 22 wherein the set of plausible reconfiguration is determined by iterating through features associated with said one or more printers **(column 7, lines 48-67; note that the scores associated with printers PRN1-PRN3 is described. Also, the scores are given according to the speed configuration of the printers which is considered as the iterating feature of printers based on their speed capacity).**

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owa et al. (US Patent Number 6,348,971 B2) and Van Oijen (US Patent Number 5,918,988) as applied to claim 1 above, and further in view of Ueda et al. (US Patent Number 7,046,383 B1).

Regarding claim 3: Owa et al. disclose a method as claimed in claim 1, in which the method involves prior to step iv) the steps of v) calculating an economic cost for effecting each of a plurality of possible reconfigurations for which the printer

configuration(s) would be capable of satisfying the printing requirement (s) of said one or more print job(s) (**column 7, line 67-column 8, line 4; note that the printer most satisfying the conditions desired by users is selected automatically**); and vi) selecting according to the calculated economic costs one or more preferred reconfigurations of said one or more printer(s) for which reconfiguration instructions will be presented to said user (**column 7, lines 23-67; note that according to the scores given to printers PRN1-PRN3, user gets instructed or updated of the configurations**).

Owa et al. and Van Oijen disclose all of the subject matter as described as above except for specifically teaching calculating an economic cost for effecting each of a plurality of possible reconfigurations and selecting to the calculated economic costs.

However, Ueda et al. teach calculating an economic cost for effecting each of a plurality of possible reconfigurations (**column 7, lines 41-59; note that a cost calculating means is informed of the performance of each printers beforehand and the display means displays the printers together with additional information or attributes particular thereto, such configurations also include cost, printing time, image quality/resolution etc.**) and selecting to the calculated economic costs (**column 5, lines 37-42, lines 48-54; note that the printer automatically gets selected based on the basis of printing cost**).

Owa et al., Van Oijen and Ueda et al. are combinable because they are from the same field of endeavor. At the time of the invention, it would have been obvious to a person of ordinary skilled in the art to calculate an economic cost for effecting each of a

plurality of possible reconfigurations and select to the calculated economic costs. The suggestion/motivation for doing so would have been in order to select and efficiently utilize a printer with most advantageous print configuration and printing cost (abstract, lines 8-11). Therefore, it would have been obvious to combine Owa et al. and Van Oijen with Ueda et al. to obtain the invention as specified in claim 3.

Regarding claim 4: Owa et al. and Van Oijen disclose all of the subject matter as described as above except for specifically teaching in which there are a plurality of preferred reconfigurations, and the reconfiguration information presented to said user includes the corresponding economic cost for each preferred configuration.

However, Ueda et al. teach in which there are a plurality of preferred reconfigurations (**column 7, lines 41-59; note that a cost calculating means is informed of the performance of each printers beforehand and the display means displays the printers together with additional information or attributes particular thereto, such configurations also include cost, printing time, image quality/resolution etc**), and the reconfiguration information presented to said user includes the corresponding economic cost for each preferred configuration (**column 5, lines 37-42, lines 48-54; note that the printer automatically gets selected based on the basis of printing cost**).

Owa et al., Van Oijen and Ueda et al. are combinable because they are from the same field of endeavor. At the time of the invention, it would have been obvious to a person of ordinary skilled in the art to calculate an economic cost for effecting each of a

plurality of possible reconfigurations and select to the calculated economic costs. The suggestion/motivation for doing so would have been in order to select and efficiently utilize a printer with most advantageous print configuration and printing cost (abstract, lines 8-11). Therefore, it would have been obvious to combine Owa et al. and Van Oijen with Ueda et al. to obtain the invention as specified in claim 4.

**(10) Response to Argument**

(a) Appellant, on page 6, argues that "page 10 and fig. 1 of the specification shows several personal computers 2, 3, 4 and explains that each personal computer has a system unit 14 and software running in each system unit 14 to perform various tasks. A person of ordinary skill in the art would understand that for software to function within a system unit of a computer, such software has to first be stored on computer readable media, such as memory".

**In response:** Appellant's assertions are incorrect. Even though the specification discloses computer and software running in each system, it does not define or disclose a memory or storage medium wherein the software is stored. The claim calls for the "computer readable medium", but there is no support or disclosure for the computer readable medium as claimed. Thus, the stated argument is not persuasive.

(b) Appellant, on page 7, argues that "claim 14 specifically recites a computer program that is stored on computer readable media and that is adapted to program one or more processors of a computer system to perform the tasks recited in claim 14".

**In response:** Appellant's assertions are incorrect. There is no support found for "a computer readable media" such that would make the claim statutory. As claimed, "computer readable medium" implies the "data carrier" which is considered as a non-functional descriptive material as there is no disclosure if the "data carrier" is a storage media or a signal. Thus, "When nonfunctional descriptive material i.e. "data carrier" is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement", see MPEP 2106.01. Thus, the stated argument is not persuasive.

(c) Appellant, on page 8, argues that Van Oijen does not teach "when one or more of the print jobs cannot be printed using said at least one printer on the basis of said plurality of different printing configurations, automatically determining at least one reconfiguration of the printer configuration(s) that would be capable of satisfying the printing requirements(s) of said one or more print job(s)".

**In response:** Appellant's assertions are incorrect. As explained in Van Oijen when one or more of the print jobs cannot be printed using said at least one printer on the basis of said plurality of different printing configurations, automatically determining at least one reconfiguration of the printer configuration(s) that would be capable of satisfying the printing requirements(s) of said one or more print job(s) (column 4, lines 29-42; a check is made whether the job size is such that it must be characterized as "longjob", if this is not the case then the print criteria is not satisfied. When it is determined that the printer criteria/configuration is not met, a marker "C" appears with



this job so that the operator will see that is why the job is not been carried out. Note that, in column 6, lines 1-29, when the configuration of printing for the job is not met, the marker "C" appears automatically to let operator know of why the job is not carried out. Such "checkplot C" helps to automatically determine if the print criteria/configuration has not been satisfied and it is included in an "expression". The expression has a TRUE or FALSE evaluation i.e. automatical, wherein it gives the operator a chance to select suitable parameters/reconfigurations). Thus, the stated argument is not persuasive.

(d) Appellant, on page 13, argues that Owa et al. do not teach "there are a plurality of different preferred reconfigurations, and that prior to step(iv) these preferred configurations are presented to a user of the printing system so that the user can select a particular reconfiguration for which reconfiguration instructions are then presented in step(iv)".

**In response:** Appellant's assertions are incorrect. As described in Owa et al. there are a plurality of different preferred reconfigurations, and that prior to step(iv) these preferred configurations are presented to a user of the printing system so that the user can select a particular reconfiguration for which reconfiguration instructions are then presented in step(iv) (column 5, line 64-column 6, line 5; note that there are print conditions wherein user could be able to select in order to execute the print job. In column 6, line 22-26, it is disclosed that user is able to change the print job configuration in order to suit it with the printer's properties, see figure 6, S8, S12).

(e) Appellant, on page 13, argues that Owa et al. do not teach "at least one reconfiguration of the printer configuration(s) capable of satisfying the printing requirement(s) of the print job(s) is determined by automatically analyzing a set of plausible reconfigurations"

**In response:** Appellant's assertions are incorrect. As described in Owa et al. at least one reconfiguration of the printer configuration(s) capable of satisfying the printing requirement(s) of the print job(s) is determined by automatically analyzing a set of plausible reconfigurations, (column 6, lines 22-27; note that if the condition item "paper size" is assigned priority the paper size set in the user print condition is IB4 and "print scaled to A4 side may be selected" as an alternative condition i.e. the selection is plausible configuration/selection). Thus, the stated argument is not persuasive.

(f) Appellant, on page 14, argues that neither Owa et al. nor Van Oijen disclose "determining automatically at least one reconfiguration of the printer configuration(s) that would be capable of satisfying the printing requirement(s) of the print job(s), when one or more of the print jobs cannot be printed using the printer(s) on the basis of the current printing configuration".

**In response:** Appellant's assertions are incorrect. As explained in Van Oijen determining automatically at least one reconfiguration of the printer configuration(s) that would be capable of satisfying the printing requirement(s) of the print job(s), when one or more of the print jobs cannot be printed using the printer(s) on the basis of the current printing configuration, column 4, lines 29-42; a check is made whether the job

size is such that it must be characterized as "longjob", if this is not the case then the print criteria is not satisfied. When it is determined that the printer criteria/configuration is not met, a marker "C" appears with this job so that the operator will see that is why the job is not been carried out. Note that, in column 6, lines 1-29, when the configuration of printing for the job is not met, the marker "C" appears automatically to let operator know of why the job is not carried out. Such "checkplot C" helps to automatically determine if the print criteria/configuration has not been satisfied and it is included in an "expression". The expression has a TRUE or FALSE evaluation i.e. automatical, wherein it gives the operator a chance to select suitable parameters/reconfigurations). Thus, the stated argument is not persuasive.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Hilina S Kassa/

Examiner, Art Unit 2625

September 03, 2009

/King Y. Poon/

Supervisory Patent Examiner, Art Unit 2625

Art Unit: 2625

Conferees:

/King Y. Poon/

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